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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LOPEZ, CARLOS N	
ART UNIT	**PAPER NUMBER**
1731	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/801,358	JUPE ET AL.	
	Examiner	Art Unit	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 44-56 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 44-56 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 16 March 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 3 IDS's.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 44 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Tateno et al (US 4,889,144). Tateno discloses a filter for tobacco smoking, which comprises a filter tip having a space therein, with flavor-sealed particles being contained in the space. The flavor-sealing particles are composed of a natural polysaccharide, or its derivative, and diluent agent, and are destroyed, in order to release the flavor sealed therein, by the application of a force to the outer surface of the filter, which is greater than a force normally applied to the filter in a smoking action. Tanteno's filter comprises of two types of particles. Particles designated as element 3 are the flavor particles and particles designated as element 4 are "destruction accelerator" particles which as noted in Col. 3, line 35ff are crystalline table salt. It is deemed that the particles of crystallized table salt, sodium chloride, are the claimed adsorbent particles as evidenced by Rozim US 2005/1661055 at paragraph 16 noting that crystallized sodium chloride, salt, is a good adsorbent. Additionally as shown in figure 4, some of the flavorant particles 3 are located downstream the bed formed by some of the adsorbent particles 4, meeting applicant's claimed invention of having flavorants downstream a bed of adsorbent particles.

As for claim 49, the cavity 2b as shown in figure 4 is at least 85% filled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 44, 45, 47, 49 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry et al (US. Pat. No. 5,568,819). Gentry discloses a multi-component cigarette filter (30) comprised of a first segment adsorbent section 70 and filter second segment section 72. Section 70 is formed of paper having carbonaceous material or paper (See Col. 4,lines 55ff). Paper is essential a mass of wood fiber as such it is deemed as reading on the claimed limitation of "adsorbent particles" wherein the particles are the actual wood fibers massed to form a paper web that is deemed as the claimed "bed". The word "bed" is merely being interpreted as a heap or agglomeration of mass. However, applicant is invited to provide further structural features that the define the claimed "bed."

The second segment as noted in col. 5,lines 25ff is made of filtering material, which Gentry at Col. 10, lines 1ff further teaches of having flavoring agents. Consequently the claimed flavor-releasing component is Gentry's second segment having flavorants.

Hence, the claimed invention is anticipated or alternatively obvious to a person of ordinary skill in the at the time the invention was made in view of Gentry because a paper web encompasses "bed of adsorbent particles." Applicant may argue that a "bed

of adsorbent particles" is not paper, it is noted that paper is a heap or agglomeration of wood fibers that are deemed as an adsorbent to tobacco smoke. Alternatively, the carbon particles in the paper web is deemed as being a "bed of adsorbent particles" since when placed in the filter it forms a heap and/or agglomeration of carbon particles.

As for claim 45, Col. 15, lines 50ff the carbon containing paper is activated carbon which in combination with the teaching noted in Col. 10, line 1ff of having the filter material with flavoring agent, the claimed invention of having a adsorbent particles including flavorant-bearing activated carbon is arrived.

As for claim 47, second segment 72 is cellulose acetate as noted in Col. 5, lines 35ff in combination with the teaching noted in Col. 10, line 1ff of having the filter material with flavoring agent, the claimed invention of having cellulose acetate with flavorant thereon is arrived.

As for claim 49, it is clear or at least obvious to a person of ordinary skill in the art based on the figures of Gentry that the segments of the multi-component filter is filled to at least 85% or alternatively to have filled the segments with at least 85% to assure effective filtering of the tobacco smoke.

As for claim 55, the amount of carbon claimed is disclosed in Col. 8, lines 1ff of Gentry wherein the claimed filled segments are at least fully filled as shown in the figures of Gentry.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry et al (US. Pat. No. 5,568,819) in view of Allen et al (US 5,474,095). Gentry is silent disclosing the claimed cellulose band enclosing the tobacco rod.

Allen teaches of making tobacco rod paper wrapper by depositing additional material, such as pulp stock (deemed as comprising the claimed cellulose), onto a base web of pulp of generally uniform thickness in the web-forming area of a paper machine in either wet or dry methods of paper production. The additional stock additional stock material is deposited onto the base web by means of a rotating drum having a plurality of longitudinal slits through which the pulp passes. The paper wrapper once incorporated into a smoking article,

promotes an overall decrease in the static burn rate of the smoking article (See Col. 2,lines 43ff. As noted in Col. 2, lines 19ff, the produced cigarette reduces that amount of burn retardants used in wrapping material. Burn retardants contribute to undesirable flavors of the smoking article.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use the tobacco rod wrapper taught by Allen, having the claimed cellulose bands, for Gentry's tobacco rod in order to provide the above noted advantages such as a reduced amount of burn retardant that contributes undesirable flavors in cigarettes.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno et al (US 4,889,144) in view of Allen et al (US 5,474,095). Tateno is silent disclosing the claimed cellulose band enclosing the tobacco rod.

Allen teaches of making tobacco rod paper wrapper by depositing additional material, such as pulp stock (deemed as comprising the claimed cellulose), onto a base web of pulp of generally uniform thickness in the web-forming area of a paper machine in either wet or dry methods of paper production. The additional stock additional stock material is deposited onto the base web by means of a rotating drum having a plurality of longitudinal slits through which the pulp passes. The paper wrapper once incorporated into a smoking article, promotes an overall decrease in the static burn rate of the smoking article (See Col. 2,lines 43ff. As noted in Col. 2, lines 19ff, the produced cigarette reduces that amount of burn retardants used in wrapping material. Burn retardants contribute to undesirable flavors of the smoking article.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use the tobacco rod wrapper taught by Allen, having the claimed cellulose bands, for Tateno's tobacco rod in order to provide the above noted advantages such as a reduced amount of burn retardant that contributes undesirable flavors in cigarettes.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-5,14, and 16-20 of U.S. Patent No. 6,761,174 ('174). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5,14, and 16-20 of '174 discloses a cigarette comprising a tobacco rod and a multi-component filter comprising a bed of adsorbent particles and ventilation at a location downstream of said bed of adsorbent particles, said bed of adsorbent particles and ventilation constructed and arranged to substantially remove of at least one smoke constituent from mainstream tobacco smoke as mainstream smoke is drawn through the filter, and at least one flavor-releasing component constructed and arranged to release flavor to mainstream smoke, the flavor-releasing filter component being located downstream of the said bed of adsorbent particles in a direction of mainstream smoke drawn through the filter.

As for claim 45, claim 2 of '174 discloses flavorant bearing, activated carbon.

As for claim 46, claim 5 discloses the claimed yarn deemed as filament in combination with cellulose.

As for claim 47, claim 3 of '174 discloses a cellulose acetate plug with flavorant thereon.

As for claim 48, claim 4 of '174 discloses flavor-releasing component includes a cellulose acetate plug surrounded by plug wrap with flavorant on the plug wrap.

As for claim 49, claim 6 discloses a cavity 85% filled with adsorbents particles.

As for claim 50, claim 16 of '174 the multi-component filter includes a component in the form of a plug defining a flow path with a transition from generally circular to generally annular to thereby produce an increased pressure drop and increased dwell time of mainstream tobacco smoke in the filter.

As for claim 51, claim 17 of '174 discloses the multi-component filter includes a component in the form of a plug providing a flow constriction downstream of the bed of adsorbent particles.

As for claims 52-53, claims 18-19 disclose the claimed flow path.

As for claim 54, claim 20 of '174 discloses the claimed concentric filter.

As for claim 55, claim 14 or '174 discloses the bed of adsorbent particles comprises a high surface area activated carbon; at least 90 to 120 mg or greater of said carbon in a fully filled condition or 160 to 180 mg or greater of said carbon in a 85% filled condition or better.

Claim 56 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1of U.S. Patent No. 6,761,174 ('174) in view of in view of Allen et al (US 5,474,095). Claim 1 of '174 is silent disclosing the claimed cellulose band enclosing the tobacco rod.

Allen teaches of making tobacco rod paper wrapper by depositing additional material, such as pulp stock (deemed as comprising the claimed cellulose), onto a base web of pulp of generally uniform thickness in the web-forming area of a paper machine in either wet or dry methods of paper production. The additional stock additional stock material is deposited onto the base web by means of a rotating drum having a plurality of longitudinal slits through which the pulp passes. The paper wrapper once incorporated into a smoking article promotes an overall decrease in the static burn rate of the smoking article (See Col. 2,lines 43ff. As noted in Col. 2, lines 19ff, the produced cigarette reduces that amount of burn retardants used in wrapping material. Burn retardants contribute to undesirable flavors of the smoking article.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use the tobacco rod wrapper taught by Allen, having the claimed cellulose bands, for '174's tobacco rod in order to provide the above noted advantages such as a reduced amount of burn retardant that contributes to undesirable flavors in cigarettes.

Claims 44 and 49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 11/346429 ('429). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of '429 discloses a cigarette comprising a tobacco rod and a multi-component filter. The filter comprises of a bed of sorbent particles and a flavoring releasing component located downstream the sorbent particles. Claim of '429 further notes of that the sorbent particles are activated carbon.

While '429 does not disclose that the activated carbon is adsorbent to mainstream cigarette smoke, it would be obvious to a person of ordinary skill in the art at the time the invention was made that activated carbon are adsorbent to mainstream cigarette smoke.

As for claim 49, claim 2 notes that the cavity is at least 85% filled.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 56 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 11/346429 ('429) in view of Allen (US 5,474,095). Claim 2 of '429 is silent disclosing the claimed cellulose band enclosing the tobacco rod.

Allen teaches of making tobacco rod paper wrapper by depositing additional material, such as pulp stock (deemed as comprising the claimed cellulose), onto a base web of pulp of generally uniform thickness in the web-forming area of a paper machine in either wet or dry methods of paper production. The additional stock additional stock material is deposited onto the base web by means of a rotating drum having a plurality of longitudinal slits through which the pulp passes. The paper wrapper once incorporated into a smoking article promotes an overall decrease in the static burn rate of the smoking article (See Col. 2,lines 43ff. As noted in Col. 2, lines 19ff, the produced cigarette reduces that amount of burn retardants used in wrapping material. Burn retardants contribute to undesirable flavors of the smoking article.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use the tobacco rod wrapper taught by Allen, having the claimed cellulose bands, for '429's tobacco rod in order to provide the above noted advantages such as a reduced amount of burn retardant that contributes to undesirable flavors in cigarettes.

This is a provisional obviousness-type double patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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